

### **REMARKS**

The Office Action has been carefully reviewed. Claims 1, 2 and 4-21 are pending.

Claims 1, 2, 4-10, 11-13, 16 and 19 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 5,407,243 to Reimann ("Reimann") in view of U.S. Patent No. 4,213,460 to Weiner ("Weiner"). *See* Office Action at ¶ 3. Claims 10 and 14 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Reimann in view of Weiner and further in view of U.S. Patent No. 4,976,718 to Daniell ("Daniell"). *See* Office Action at ¶ 4. Claim 15 has been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Reimann in view of Weiner and further in view of U.S. Patent No. 4,748,767 to Sandels ("Sandels"). *See* Office Action at ¶ 5. Claims 17, 18, 20 and 21 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Reimann in view of Weiner and further in view of U.S. Patent No. 5,282,806 to Haber *et. al.* ("Haber"). *See* Office Action at ¶ 6. Applicants respond as follows.

### **REJECTIONS UNDER 35 U.S.C. § 103.**

Claims 1, 2 and 4-21 have been rejected as allegedly unpatentable under 35 U.S.C. § 103. *See* Office Action at ¶¶ 3, 5, 6. A *prima facie* case of obviousness can be established by showing that the following three criteria are met: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. *See* MPEP §§ 2143 and 2143.03; citing *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 1981 (CCPA 1974).

Additionally, under the Examination Guidelines For Determining Obviousness Under 35 U.S.C. In View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (October 10, 2007), the Examiner may establish a *prima facie* case of obviousness by setting forth factual findings concerning the state of the art and the teachings of the applied reference(s). *See id.* at 57,527. This includes determining "the scope and content of the prior art . . . ; differences between the prior art and the claims at issue . . . ; and the level of ordinary skill in the pertinent art . . ." *Id.*; *see also* MPEP § 2141; quoting *Graham v. John Deere*, 383 U.S. 1 (1966). The Examiner must then "provide an explanation to support an obviousness rejection under 35 U.S.C. 103 . . . 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed." *Id.*

For at least the following reasons, the Examiner has failed to establish a *prima facie* case of obviousness under either of these methods. Accordingly, for at least the following reasons, Applicants respectfully request withdrawal of these rejections under 35 U.S.C. § 103(a).

**A. Claims 1, 2, 4-10, 11-13, 16 and 19.**

Claims 1, 2, 4-10, 11-13, 16 and 19 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Reimann in view of Weiner. *See* Office Action at ¶ 3. With respect to claim 1, the Examiner states that “Riemann discloses a device 110 comprising: a housing 112; a spreadable gripper tool 114; a spreader device 132, separate from the gripper tool; a rotation device 130/112; and a presser device 130 that is actuated in the axial direction of the device to actuate the spreader device and the rotation device of the gripper tool, wherein a first actuation of the presser device effects a spreading of the gripper tool by the spreading device. Riemann also discloses a second actuation that effects the rotation of the gripper tool (Rotating the ring 130 will effect rotation of the device. The rotation of the device is necessary as indicated by Reimann Col. 4 ll. 33-45). Reimann further discloses the gripper being closed by the first actuation; the recoil initiated by the spring after the first actuation has taken place will serve to close the jaws. Reimann discloses the first actuation being into the device and the second actuation is capable of being performed while also moving the device in an axial direction either into or out of the device. Reimann further discloses a spring force against which the spreading of the segments takes place (Figs. 2-3).” Office Action at ¶ 3. The Examiner states that Riemann “does not disclose the gripper tool in its un-spread position encloses an essentially closed cavity that is designed to contain a tick . . . Weiner discloses a gripper 22/24 that defines a closed cavity designed to contain a tick . . . Weiner further discloses the device having an apparatus to paralyze or kill the parasite (Col. 4 ll. 28-40) and that the gripper tool comprises a moisture dispenser (Col. 4 ll 28-40) . . . Weiner further discloses the gripper being coated in adhesive (Col. 5 ll. 5-8) . . . [i]t would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Riemann with the gripper of Weiner in order to facilitate the secure gripping of the tick with the device.” *Id.*

Applicant respectfully submits that Riemann in combination with Weiner does not support a *prima facie* case of obviousness in that the combination does not disclose each and every element of the claimed invention.

Specifically, Riemann does not disclose the limitations of claim 1 of (1) a separate rotation device for the rotation of the gripper tool around the longitudinal axis of the device and (2) a presser device that is actuated in the axial direction of the device to actuate the separate rotation device. The Examiner references an embodiment of Riemann seen in Figures 4 and 5 as allegedly disclosing these elements. Specifically, the Examiner references element 114 of Figures 4 and 5 as allegedly corresponding to the gripper tool; element 130 of Figures 4 and 5 as allegedly corresponding to the presser device of the invention, and elements 130/112 of Figures 4 and 5 as allegedly corresponding to the rotation device of the invention. *See* Office Action at ¶ 3. According to the Examiner, “[r]otating the ring 130 will effect rotation of the device . . . [t]he rotation of the device is necessary as indicated by Reimann Col. 4 ll. 33-45) . . . Reimann discloses . . . the second actuation is capable of being performed while also moving the device in an axial direction either into or out of the device.” *Id.*

Respectfully, Applicants disagree with the Examiner’s conclusions that Reimann discloses a separate rotation device at all, much less discloses rotation of a rotation device by way of actuation of the presser device in the axial direction of the tick removing device that rotates a gripper tool around the longitudinal axis of the device. In fact, there is not even any disclosure in Reimann that rotation of the *entire* device of Reimann is effectuated by an actuation of the presser device in the axial direction of the device.

Reimann expressly discloses only that actuation of the presser device in the axial direction opens gripping points 126 and 128. *See* col. 5, lines 12-23 (“The user opens tick removing device **110** by depressing the head **130** of the gripping device **114** with his or her thumb such that gripping device **114** moves forwardly through sleeve **112**. Gripping points **128** and **130** [sic] open as sleeve **112** is retracted and gripping legs **122** and **124** move past the front end **116** of sleeve **112**.”) Accordingly, actuation of the presser device in the axial direction of the tick removing device of Reimann will *only* extend or retract the gripping legs, causing the gripping legs to then open or close. There is no disclosure of a separate rotation device at all in Reimann, much less rotation of a rotation device by way of actuation of the presser device in the axial direction of the tick removing device that rotates a gripper tool around the longitudinal axis of the device. In fact, the only disclosure in Reimann at all of *any* rotation is rotation of the *entire* tick removing device, not merely the gripping tool. Even then, Reimann expressly

discloses that rotation of the *entire* tick removing device is effectuated by the *user*, who rotates the *entire* tick removing device *by rotating the device two to three counterclockwise revolutions*. See, e.g., col. 5, lines 40-42 (“Once the tick has become gripped by the tick removing device **110**, the user rotates the tick removing device **110** two to three counterclockwise revolutions.”) This rotation is *not* caused by actuation of the presser device in the axial direction of the tick removing device.

In contrast, as claimed in claim 1, the rotation device rotates the gripper tool by movement (*i.e.*, actuation) of the presser device in the *axial direction of the device*, compared to Reimann which requires rotation of the entire device using the user’s wrist and hand to rotate the Reimann tick removing device. The operation of the device of claim 1 is particularly advantageous in situations where there is limited space for movement of the user’s wrist and hand, such as removing ticks in “difficult” parts of the body such as the armpit. See paragraph [0023] of U.S. Published Patent Appln. Publn. No. 2007/018552A1.

Accordingly, the tick removing device of Riemann does not meet the limitations of the invention of claim 1 in that there is no disclosure, either expressly or inherently, of (1) a separate rotation device for the rotation of the gripper tool around the longitudinal axis of the device and (2) a presser device that is actuated in the axial direction of the device to actuate the separate rotation device.

Weiner does not cure the deficiencies of Riemann. Weiner discloses a tick removal tool comprising “an openable clamp structure having a compression spring to hold two pivotally attached clamping jaws normally closed at one end.” Col. 1, lines 50-54. However, Weiner does not disclose the limitations of claim 1 of (1) a separate rotation device for the rotation of the gripper tool around the longitudinal axis of the device and (2) a presser device that is actuated in the axial direction of the device to actuate the separate rotation device. Accordingly, the combination of Riemann and Weiner does not support a *prima facie* case of obviousness and Applicants respectfully request that this rejection be withdrawn. Further, since claims 2, 4-10, 11-13, 16 and 19 depend from claim 1, the rejection of these claims should be similarly withdrawn.

**B. Claims 10 and 14.**

Claims 10 and 14 have been rejected as allegedly unpatentable under 35 U.S.C. § 103

over Reimann in view of Weiner and further in view of Daniell. *See* Office Action at ¶ 4. The Examiner states that “Reimann in view of Weiner discloses the invention essentially as claimed as discussed above . . . Reimann in view of Weiner does not disclose the segments of the gripper being elastic or comprising barbs . . . Daniell discloses the segments of the gripper comprising barbs which due to their plastic construction will exhibit elastic recoil when bent . . . [i]t would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Riemann in view of Weiner with the barbs of Daniell to facilitate the closing surrounding [sic] of the parasite without crushing or squeezing as taught by Daniell (Abstract II. 12-17).” *Id.*

Since claims 10 and 14 are dependent from claim 1, Applicants respectfully submit that these claims are not obvious over Riemann in view of Weiner and further in view of Daniell for the reasons previously stated for claims 1, 2, 4-10, 11-13, 16 and 19. Specifically, the combination of Reimann and Weiner fails to disclose (1) a separate rotation device for the rotation of the gripper tool around the longitudinal axis of the device and (2) a presser device that is actuated in the axial direction of the device to actuate the separate rotation device, which deficiencies are not cured by the disclosure of Daniell. Accordingly, the combination of Riemann, Weiner and Daniell does not support a *prima facie* case of obviousness of claims 10 and 14, and Applicants respectfully request that these rejections be withdrawn.

**C. Claim 15.**

Claim 15 has been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Reimann in view of Weiner and further in view of Sandels. *See* Office Action at ¶ 5. The Examiner states that “Reimann in view of Weiner discloses the invention essentially as claimed as discussed above . . . Reimann in view of Weiner does not disclose the device comprising a suction device connected to the gripper being. . . Sandels discloses using a suction device 14 connected to the gripper 4 . . . [i]t would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Riemann in view of Weiner with the suction device of Sandels in order to cause the tick to release its bite and move to a new location in search of air as taught by Sandels (Col. 3 ll. 28-30).” *Id.*

Since claim 15 is dependent from claim 1, Applicants respectfully submit that this claim is not obvious over Riemann in view of Weiner and further in view of Sandels for the reasons

previously stated for claims claims 1, 2, 4-10, 11-13, 16 and 19. Specifically, the combination of Reimann and Weiner fails to disclose (1) a separate rotation device for the rotation of the gripper tool around the longitudinal axis of the device and (2) a presser device that is actuated in the axial direction of the device to actuate the separate rotation device, which deficiencies are not cured by the disclosure of Sandels. Accordingly, the combination of Riemann, Weiner and Sandels does not support a *prima facie* case of obviousness of claim 15, and Applicants respectfully request that this rejection be withdrawn.

**D. Claims 17, 18, 20 and 21.**

Claims 17, 18, 20 and 21 have been rejected as allegedly unpatentable under 35 U.S.C. § 103 over Reimann in view of Weiner and further in view of Haber. *See* Office Action at ¶ 6. The Examiner states that “Reimann in view of Weiner discloses the invention essentially as claimed as discussed above . . . Reimann in view of Weiner does not disclose the gripper tool being interchangeable, or an ejector device for the ejection of the gripper tool . . . Haber et. al. discloses the gripper being interchangeable and replaceable (Col. 1 ll. 66-68) . . . Haber et. al. further discloses an ejector device that detaches the gripper tool . . . [i]t would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Riemann in view of Weiner with the gripper and ejector of Haber et. al. in order to quickly adapt the device to the needs of the physician.” *Id.*

Since claims 17, 18, 20 and 21 are dependent from claim 1, Applicants respectfully submit that these claims are not obvious over Riemann in view of Weiner and further in view of Haber for the reasons previously stated for claims 1, 2, 4-10, 11-13, 16 and 19. Specifically, the combination of Reimann and Weiner fails to disclose (1) a separate rotation device for the rotation of the gripper tool around the longitudinal axis of the device and (2) a presser device that is actuated in the axial direction of the device to actuate the separate rotation device, which deficiencies are not cured by the disclosure of Haber. Accordingly, the combination of Riemann, Weiner and Haber does not support a *prima facie* case of obviousness of claims 17, 18, 20 and 21, and Applicants respectfully request that these rejections be withdrawn.

**E. The Examiner has not set forth a case for obviousness under the new Examination Guidelines.**

The Examiner has also not set forth a case of obviousness of claims 1-5 under the new

Examination Guidelines as set forth at 72 Fed. Reg. 57,526 (October 10, 2007). The new Guidelines state that some rationale must be set forth that outlines the reasoning why an invention is obvious. *See id.* at 57,528 (III). Suggested but non-inclusive rationales are described including:

1. Combining prior art elements according to known methods to yield predictable results;
2. Simple substitution of one known element for another to obtain predictable results;
3. Use of known techniques to improve similar devices (methods, or products) in the same way;
4. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
5. "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
6. Known work in one field of endeavor that may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
7. Some teaching, suggestion or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicants have already addressed the last rationale listed above and respectfully submit that the Examiner has not set forth any of the other rationales (or any other rationales either) to support a finding of obviousness.

**CONCLUSION**

Applicants respectfully submit that claims 1, 2 and 4-21 are in condition for allowance and request allowance of the same.


This Amendment and Response has been filed within three months of the mailing date of the Office Action and it is believed that no fees are due for this filing. If any fees are determined to be due, the Commissioner is hereby authorized to charge such fees to the undersigned's EFT Account.

Respectfully submitted,

NANCY J. FLINT, ATTORNEY AT LAW, P.A.

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By:

  
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Nancy J. Flint  
Registration No. 46,704